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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,331	08/14/2001	Yu-Sam Chang	112.P14038	8693
43831 7590 06/27/2007 BERKELEY LAW & TECHNOLOGY GROUP, LLP 17933 NW Evergreen Parkway, Suite 250 BEAVERTON, OR 97006			EXAMINER LEE, CHEUKFAN	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 06/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/929,331	CHANG ET AL.	
	Examiner	Art Unit	
	Cheukfan Lee	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec. 4, 2006 & a petition granted 4/4/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-5 and 16 are pending. Claim 16 is newly added. Claim 1 is independent.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung (U.S. Patent No. 6,587,231) in view of Matsumoto (U.S. Patent No. 6,147,339).

Regarding claim 1, Sung discloses a scanning apparatus comprising a scanning housing assembly (transparent housing 1) having an integrally formed document-loading panel (2), wherein the housing assembly (1) and integrally formed document-loading panel (2) comprises a high-strength and transparent material (col. 2, lines 35-43). Please note that this embodiment of Sung describes a housing assembly (1) that is of hollow box shape and has an upper transparent window (2) and a lower transparent window (3) with border marked on the top surface (10) and bottom surface (11) thereof (Fig. 1, col. 2, lines 35-42), meaning that the border of the transparent panel (2) of the transparent panel (2) is defined by marking the top transparent surface (10) of the transparent housing (1).

The upper transparent window (2) meets the claimed document-loading panel. Sung does not specify that the transparent material used to make the transparent housing (1) is acrylic.

Matsumoto discloses an image sensor module comprising a scanning window (18) and a part (18b) of the frame, the scanning window (18) and frame part 918b) being integrally formed of molding transparent material, acrylic (Fig. 1, col. 3, lines 62-66).

Matsumoto teaches forming a scanning window and part of the frame by integral molding transparent acrylic material.

The transparent housing (1) of Sung is made of high-strength and transparent material as discussed above. One of ordinary skill in the art would have recognized that transparent acrylic is a high strength and transparent material (when formed with the proper thickness).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ transparent acrylic as the transparent material for forming the transparent housing of Sung, including the scanning window (2), as suggested by Matsumoto, because acrylic is of high-strength and transparent material as required by Sung (col. 2, lines 36-37).

Regarding claim 4, see scanner cover (7) in Figs. 5 and 6 of Sung.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sung (U.S. Patent No. 6,587,231) in view of Matsumoto (U.S. Patent No. 6,147,339) as applied to claim 1 above, and further in view of Hu et al. (U.S. Patent No. 6,271,939).

Regarding claim 2, the obvious apparatus of Sung in view of Matsumoto discussed for claim 1 above does not have a chart printed on the document loading panel (scanning window). However, such feature is not novel and is taught by Hu et al. in which a scale or a grid (chart) is printed on a transparent window of a scanner (col. 5, lines 15-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a chart on the transparent window of Sung in view of Matsumoto, as taught by Hu et al. to assist the user of the scanner. Sung further discloses a scanner cover (7 in Figs. 5 and 6, col. 3, lines 52-55).

6. Claims 3, 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung (U.S. Patent No. 6,587,231) in view of Matsumoto (U.S. Patent No. 6,147,339) as applied to claim 1 above, and further in view of Motamed (U.S. Patent No. 6,327,047).

Regarding claims 3 and 5, the obvious scanner apparatus of Sung in view of Matsumoto discussed for claims 1 above does not have a chart coupled to the transparent, document loading panel or window, or coupled to a document cover of the scanner apparatus. However, such feature is not novel and is taught by Motamed, in which a chart (calibration target 200) is coupled (adhered) to a surface of the

transparent window (210) for placing a document to be scanned (Fig. 2A, col. 5, lines 13-25), or coupled to the inside of the scanner cover (Figs. 2B, col. 5, lines 26-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to couple a chart to a transparent, document loading panel, or couple a chart to the inside of a scanner cover, as taught by Motamed, in order to either assist the user or to provide a target for the scanner calibration. Sung further discloses a scanner cover (7 in Figs. 5 and 6, col. 3, lines 52-55).

7. Response to Applicant's Arguments

Applicant argues that the combination of Sung (6,587,231) and Matsumoto (6,147,339) is improper. Applicant states that "[i]t is noted that the section Sung which the Examiner cites (col. 2, lines 36-37) pertains to the transparent housing (1) and not to either of the transparent windows (2, 3) which form separate parts, not integral with the housing." Applicant then concludes that there is no disclosure or suggestion in Sung that "a document-loading panel is made of transparent acrylic material" as claimed in claim 1. See page 5 of the Remarks.

The above statement is not all correct. First, the Examiner cited not only lines 36-37 of col. 2 of Sung but also the section at col. 2, lines 35-40 (see section 4 on page 2 of the Office Action). Secondly, that section at col. 2, lines 35-42 of Sung clearly states the following:

"The transparent housing 1 is integrally made of high-strength and transparent material. Moreover, the transparent housing 1 can be decorated with opaque part on the portion

where transparency is not required. The transparent housing is of hollow box shape and has an upper transparent window 2 and a lower transparent window 3 with border marked on the top surface 10 and the bottom surface 11 thereof."

Clearly, the transparent housing (1) has an upper transparent window (2) and a lower transparent window (3), with both windows (2, 3) defined by marking on the top surface (10) and the bottom surface (11), respectively, of the housing (1). Not only the windows (2 and 3) are transparent but also other parts of the transparent housing (1) as well. Col. 1, lines 57-59 also clearly states the following:

"The upper surface and the lower surface of the transparent housing are marked to define a transparent upper window and a lower transparent window."

It is clear from the above that the transparent windows (2, 3) are integral parts of the transparent housing (1), as opposed to separate transparent windows (2, 3) formed separately from the transparent housing (1) of an alternative embodiment (Fig. 2, col. 2, lines 43-49).

Therefore, Sung discloses that a document-loading panel (2) is made of transparent material which is the teaching of Sung that the previous Office Action relied on.

Applicant further states that the transparent window (18) of Matsumoto located at the bottom of the apparatus does not constitute a document loading panel, as the apparatus of Matsumoto does not hold documents, because the document scanner of Matsumoto is a hand-held portable scanner that rolls over a document. In the previous Office Action, Matsumoto is relied on for its transparent acrylic scanning window (18).

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Both the transparent window (2) of Sung and the transparent window (18) of Matsumoto are scanning windows through which light from a light source inside the apparatus is transmitted and light reflected by a document during scanning of the document. One of ordinary skill in the art would have realized that a scanning window made of transparent acrylic material, such as the acrylic scanning window (18) of Matsumoto, is strong enough to hold a document, which is of relatively light weight.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ transparent acrylic material as the transparent material for forming the transparent housing (1) including the transparent window (2) of Sung.

For the reasons given above, the rejection of claims 1 and 4 stands.

With respect to claim 2, Applicant's arguments mainly rely on Applicant's reasoning regarding the limitations of claims 1, 6 and 11. Thus, the rejection of claim 2 stands for the same reasons as given for claims 1 and 4.

For claims 3, 5 and 16, similarly, Applicant's arguments mainly rely on the reasoning regarding the limitations of claim 1. Thus, the rejection of claims 3, 5, and 16 stands for the same reasons as given for claim 1.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheukfan Lee
June 8, 2007